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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,222	02/09/2001	Andrew M. Schwarzbauer	38916/24384	5359
1688	7590	12/29/2004	EXAMINER HENDERSON, MARK T	
POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			ART UNIT 3722	PAPER NUMBER
DATE MAILED: 12/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,222

Applicant(s)

SCHWARZBAUER ET AL.

Examiner

Mark T Henderson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,4,6,8-14 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4,6,8-14, 24-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Drawings***

1. The drawings are finally objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number "20" and 21 are not shown in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 4, 6, 8-14 and 24-38 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (6,328,340) in view of Matsuguchi et al (EP-426,863).

Fischer discloses in Fig. 3a and 3b, a form with an integrated card comprising: a primary film (21) having top and bottom surfaces and a periphery; a breakaway layer (22) constructed of translucent urethane acrylic, and capable of accepting printed indicia (Col. 5, lines 20-25) and disposed between the primary layer (21, wherein the breakaway layer is adhesively coated (24) on top) and a secondary layer (28); a die-cuts (31); and a base paper layer (1) having top and bottom surfaces; an adhesive layer (24) that secures (however, not directly) the base paper layer (1) to the breakaway layer (22); and an information card comprised of the die-cut base paper (1), adhesive layer (24), and the breakaway layer (22); and wherein the breakaway layer (22) has a greater affinity for the adhesive layer (24) than the top surface of the primary film layer (21) such that when the card is removed, the breakaway layer stays adhered to the bottom surface of the

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adhesive layer (24); and wherein the primary film layer also has predetermined areas (area in which the information card is pulled upon) of greater and lesser affinity for the break away layer .

However, Fischer does not disclose: a breakaway layer composed of a material having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer.

Matsuguchi et al discloses in Fig. 13A-14B, a form with an integrated card comprising a breakaway layer (24) having release levels with respect to the primary film layer (12) that vary in a predetermined pattern (Col. 14, lines 5-44, wherein the release levels have a greater affinity for the adhesive layer (20) at areas without breakaway layer component (24) and have less affinity for the adhesive layer (20) at areas which have the polymer component (24)); wherein the breakaway layer is composed of a material (22) that varies in thickness at different points along and across the primary film layer (12); wherein the die-cuts (26a and 26b) fall within an area having lower release levels of the breakaway layer (Fig. 14b); and further wherein the area of greater affinity is adjacent or spaced from the periphery of the primary film layer (as seen in Fig. 13b).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fischer's form with a breakaway pattern having varied release levels with respect to the primary film layer that vary in a predetermined pattern as taught by Matsuguchi et al for the purpose of allowing the integrated card to be peeled off from the form relatively easily.

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***Response to Arguments***

3. Applicant's arguments filed on July 21, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the Fischer reference with the Matsuguchi et al reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case the Fischer reference is relied upon for disclosing an integrated card and form assembly comprising a primary film, a printable adhesively coated breakaway layer, a secondary layer, die cuts, and a base paper layer; wherein the breakaway layer has a greater affinity for the adhesive layer than the top surface of the primary layer, such that when the card is removed, the breakaway layer stays adhered to the bottom surface of the adhesive layer. However, Fischer does not disclose a breakaway layer composed of a material having release levels that vary in a predetermined pattern, wherein lower release levels are adjacent the periphery of the primary film layer. Matsuguchi et al is cited for disclosing an integrated card and form assembly comprising breakaway layer (24) having release levels with respect to the primary film layer (12) that vary in a predetermined pattern (Col. 14, lines 5-44, wherein the release levels have a greater affinity for the adhesive layer (20) at areas without breakaway layer component (24, as shown in Fig. 13B

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and 14B) and have less affinity for the adhesive layer (20) at areas which include the polymer component (24)); wherein the breakaway layer is composed of a material (22) that varies in thickness at different points along and across the primary film layer (12); wherein the die-cuts (26a and 26b) fall within an area having lower release levels of the breakaway layer (Fig. 14b); and further wherein the area of greater affinity is adjacent or spaced from the periphery of the primary film layer (as seen in Fig. 13b).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fischer's form with a breakaway pattern having varied release levels with respect to the primary film layer that vary in a predetermined pattern as taught by Matsuguchi et al for the purpose of allowing the integrated card to be peeled off from the form relatively easily without mistakenly detaching the primary layer from the base layer.

Therefore, the rejections have been maintained.

### ***Conclusion***

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

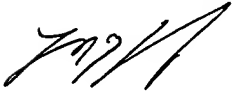
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9306.



MTH

December 22, 2004



Joseph J. Hail, III  
Supervisory Patent Examiner  
Technology Center 3700